

REMARKS

The office action of May 20, 2008, has been carefully considered.

It is noted that claims 10-13 are rejected under 35 U.S.C. 102(b) over the patent to D'Alessandro, et al.

Applicant submits that the claims currently on file differ essentially and in an unobvious, highly advantageous manner from the methods disclosed in the reference.

The Examiner has cited the same reference which was relied upon in the last office action. Applicant once again submits that the Examiner is misinterpreting the teachings of D'Alessandro, et al. Applicant requests that the Examiner reconsider her position. Although D'Alessandro, et al. apply a voltage to protect the membrane on the anode, it is not inherent that electrolysis is present. D'Alessandro, et al. do not disclose applying an external voltage to the fuel cells to produce a reducing atmosphere at the anodes by electrolysis. There is no disclosure of applying a voltage to induce electrolysis, as in the presently claimed invention. The Examiner's assertion that electrolysis would be inherent in D'Alessandro, et al. is misplaced.

To begin with, D'Alessandro, et al. do not disclose the method step of applying an external voltage to the fuel cells to produce a reducing atmosphere at the anodes by

electrolysis. Applicant submits that no electrolysis takes place in D'Alessandro, et al. because the anode is flushed with only inert gasses. If electrolysis were present a non-inert gas would be present in the vicinity of the anode. As has previously been pointed out, this is directly the opposite of what is intended by D'Alessandro, et al.

Furthermore, based on the case law cited by the Examiner, "the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed.Cir. 1993)." The Examiner correctly goes on to cite *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) for the holding that "the Examiner must prove a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art." To do this, the Examiner has merely stated that "the basis for expectation of inherency is that D'Alessandro et al.'s method uses steps employed by the instant application." Applicant submits that this on its face does not meet the requirements of *Ex parte Levy*. The Examiner has provided no basis in fact and/or technical reasoning to support her determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. There is nothing in the teachings of D'Alessandro, et al. which would suggest applying an external voltage to the fuel cells to induce electrolysis to produce a reducing atmosphere at the anodes. As has previously been pointed out, there is no discussion or disclosure

by D'Alessandro, et al. of electrolysis taking place. There is no disclosure by D'Alessandro, et al. of imparting sufficient voltage to induce electrolysis. Thus, one skilled in the art would logically take away from the teachings of D'Alessandro, et al. that the voltage is smaller than the decomposition voltage necessary for electrolysis to take place. The voltage of D'Alessandro, et al. is disclosed to only serve as a protection potential.

In the Examiner's response to arguments section of the office action the Examiner makes a number of conclusory statements rather than provide the "basis and fact and/or technical reasoning" which is required to support the rejection based on inherency. The Examiner states that "The fact that D'Alessandro, et al. does teach of flushing with inert gases, it does not negate the fact that steam is taught to be used, wherein steam (water vapor) electrolyzes upon the application of a current." The Examiner states that no proof has been provided, that the process used by D'Alessandro, et al. would not inert via electrolysis of the steam. Applicant asserts that D'Alessandro, et al. specifically mentions steam as a suitable inert gas (See column 2, beginning with line 64). As has been previously pointed out, in order for electrolysis to take place a non-inert gas would be present, which is directly the opposite of what D'Alessandro, et al. intend. Therefore, applicant submits that the position taken by the Examiner on inherency is totally contrary to the teachings and disclosure of D'Alessandro, et al. and there is no basis in fact and/or technical reasoning that has been provided to reasonably

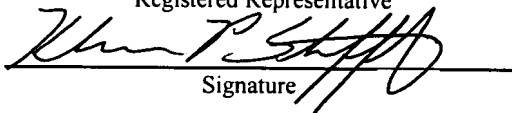
support a determination that the allegedly inherent characteristic necessarily flows from the teachings of D'Alessandro, et al.

In view of these considerations, it is respectfully requested that the Examiner reconsider and withdraw the rejection of the claims under 35 U.S.C. 102(b) over D'Alessandro, et al.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on August 20, 2008

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Name of applicant, assignee or
Registered Representative

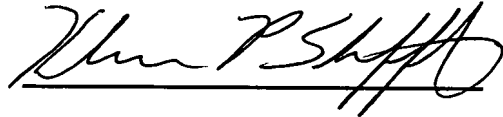

Signature

August 20, 2008

Date of Signature

KPS:mj

Respectfully submitted,



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